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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,879	12/16/1999	JOHN L. BEEZER	5486-0119PUS1	9430
67321 7590 01/11/2008 BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 GATEHOUSE ROAD SUITE 100 EAST FALLS CHURCH, VA 22040-0747			EXAMINER TRAN, MYLINH T	
			ART UNIT 2179	PAPER NUMBER
			MAIL DATE 01/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/465,879

Applicant(s)

BEEZER ET AL.

Examiner

Mylinh Tran

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,9,12,22,27,29-40,42-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 9, 12, 22, 27, 29-40, 42-45, 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/05/07 has been entered.

Claims 1, 9, 33, 42 and 49 have been amended. However, the limitations of the amended claims have not been found to be patentable over prior art of record; therefore, claims 1, 4, 9, 12, 22, 27, 29-40, 42-45 and 47-49 remain rejected under the same ground of rejection as set forth in the Office Action mailed (07/05/07).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly

owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 9, 22, 27, 29, 31, 33-40, 42-45 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henckel et al. [US. 5,463,725] in view of Microsoft PowerPoint 97 "Hutchinson".

**As to claims 1 and 9**, Henckel et al. discloses a computer implemented method and corresponding apparatus for displaying at least a portion of the electronic document to the user as an immersive reading page, the immersive reading page having the visual characteristics (text, title of the page or page number) of a printed paper (figures 1-4, column 2, lines 12-66); associating navigational functionality with an interactive region of the immersive reading page (figure 1, the interactive region associates with page numbers 102,103) (Henckel et al. cite "In order to "turn the page" of the displayed book, the user touches the screen with his hand or a pointing device, and moves it across the screen." on page 1, lines 51-55. The step of "turn the page" reads as a navigational functionality of the claimed invention), wherein a page number of the immersive reading

page is displayed in the interactive region and the navigational functionality comprises displaying another immersive reading page of the electronic documents (figure 1, the interactive region associates with page numbers 102,103), (Henckel et al. cite "In order to turn this page, the user touches the display device 10 somewhere on page 103....Any other location on the face of page 103 would be suitable", on page 2, lines 51-56. The interactive region could be any where on an entire page of the displayed book); carrying out the navigational functionality in order to display another immersive reading page of the electronic document, the navigational functionality being carried out in response to the user selecting the touch-sensitive display at the interactive region corresponding to the page number of the immersive reading page (Henckel et al. cite "the user then drags his hand to the left, across the face of the display device 10, and a graphic of a turning page 28 moves with it. Thus, as the user "swipes" his hand from right to left across the surface of the display screen 10 a graphical depiction of a page turning is shown" on page 2, lines 58-62), wherein the navigational functionality associated with the page number is transparent to the user prior to the user selecting the touch sensitive display at the interactive region corresponding to the page number of the immersive reading page (Henckel et al. cite "A tuning page graphic 28 is displayed part way through this process of turning a page. In order to turn this page, the user touches the display device 10 somewhere on page 103" on page 2,

lines 50-65. Before the user swipes his hand from right to left across the surface of the display screen, the user could be able to see the page number of the immersive pages because it is transparent to the user).

Henckel fails to clearly teach the interactive region spanning only a portion of the immersive page. Hutchinson teaches the feature at (page 1, left button and right button represent a portion of the page)

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been to provide an enhanced touch-sensitive display of electronic book.

While Hutchinson teaches the interactive region spanning only a portion of the immersive page, Henckel in view of Hutchinson do not teach or suggest the feature of "tapping". While Henckel teaches the feature of "Swapping", official notice is taken that tapping the interactive region was well known in the art. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been for the ease and speed of browsing step.

**As to claims 22 and 27**, Henckel et al. teach the electronic document being a book in electronic form and the immersive reading page has the visual characteristics of a printed paper page of a book (text, title of the page or page number) of a printed paper (figures 1-4, column 2, lines 12-66);

**As to claims 29 and 31**, Henckel et al. fail to clearly teach displaying only one immersive reading page at a time. However, Hutchinson teaches the feature at figure 1. It would have been obvious to one of ordinary skill in the art, to combine displaying only one reading page at a time with Henckel's electronic book. Motivation of the combination would have been to make text bigger and easier to read.

**As to claims 33-34**, Henckel et al. discloses a computer implemented method and corresponding apparatus for displaying at least a portion of the electronic document to the user as an immersive reading page, the immersive reading page having the visual characteristics of a printed paper (text, title of the page or page number) of a printed paper (figures 1-4, column 2, lines 12-66); associating navigational functionality with an interactive region of the immersive reading page, wherein an element (figure 1, page number 102-103) of the immersive reading page is displayed in the interactive region (figure 1, page number 102-103), (Henckel et al. cite "In order to "turn the page" of the displayed book, the user touches the screen with his hand or a pointing device, and moves it across the screen." on page 1, lines 51-55. The step of "turn the page" reads as a navigational functionality of the claimed invention), the page number having a corresponding interactive region (Henckel et al. cite "In order to turn this page, the user touches the display device 10 somewhere on page 103....Any other location on the face of page 103

would be suitable", on page 2, lines 51-56. The interactive region could be any where on an entire page of the displayed book); displaying another immersive reading page of the electronic document in response to the user selecting the interactive region corresponding to the element of the immersive reading page (Henckel et al. cite "the user then drags his hand to the left, across the face of the display device 10, and a graphic of a turning page 28 moves with it. Thus, as the user "swipes" his hand from right to left across the surface of the display screen 10 a graphical depiction of a page turning is shown" on page 2, lines 58-62), wherein the navigational functionality associated with the page number is transparent to the user prior to the user selecting the interactive region corresponding to the element of the immersive reading page (Henckel et al. cite "A tuning page graphic 28 is displayed part way through this process of turning a page. In order to turn this page, the user touches the display device 10 somewhere on page 103" on page 2, lines 50-65. Before the user swipes his hand from right to left across the surface of the display screen, the user could not see the navigational functionality because it is transparent to the user).

Henckel fails to clearly teach the interactive region spans only a portion of the immersive page. Henckel also fails to teach the feature of "tapping the interactive region". However, Hutchinson teaches the interactive region spans only a portion of the immersive page (Hutchinson, figure 1); the feature of "tapping the interactive region" by the user (figure 3).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been to provide a convenient GUI.

**As to claims 35, 37 and 39**, Henckel et al. show associating additional functionality with a second interactive region of the immersive reading page, wherein an element different than the page number is displayed in the second interactive region, a, and additional functionality is different from the navigation functionality associated with the interactive region in which the page number is displayed (page 1, lines 51-55 and page 2, lines 51-56; the other element which is different than the page number is the title of the page or the text of the page. The title and text could be placed on the top of each page).

**As to claim 36, 38 and 40**, Henckel et al. teach the element being the title of the page. The user can select any region on the entire page 102 including the region associated with the book title.

**As to claims 42 and 49**, while Henckel et al. teach the page number (figure 1, page number 102-103), Hutchinson shows the interactive region including an area to the right of the navigational functionality and an area to the left of the navigational functionality and it shows the step of displaying a previous page of the electronic document in response to the user tapping the display area to the left and displaying a subsequent

page of the electronic document in response to the user tapping the display area to the right (figure 1).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been to provide a convenient GUI.

**As to claims 43-45 and 47-48**, while Henckel shows the page number (page number 103), Hutchinson shows the interactive region constitutes the navigation button (figure 1). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been to provide a convenient GUI.

Claims 4, 12, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable Henckel et al. [US. 5,463,725] in view of Microsoft PowerPoint 97 "Hutchinson" and further in view of Ho [US. 6,407,757].

**As to claims 4 and 12**, Henckel et al. in view of Hutchinson fail to clearly teach the step of invoking a training mode. However, in the same field of the invention, the claimed limitation is disclosed by Ho, column 4, lines 35-47. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Ho's teaching with the teaching of Henckel in view of Hutchinson of the immersive reading

page. Motivation of the combination would have been to provide users help to understand a book content.

**As to claims 30 and 32**, Henckel et al. in view of Hutchinson fail to clearly teach the association to the user by providing audio indicators. However, in the same field of the invention, the claimed limitation is disclosed by Ho, column 4, lines 35-47. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Ho's teaching with the teaching of Henckel in view of Hutchinson of the immersive reading page. Motivation of combining would have been to alert users when turning page.

#### ***Response to Arguments***

Applicant has argued that Hutchinson fails to teach or suggest Tapping. However, while Henckel teaches the feature of "Swapping", official notice is taken that tapping the interactive region was well known in the art. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Hutchinson with Henckel's teachings. Motivation would have been for the ease and speed of browsing step.

Applicant also argued Hutchinson's buttons are not transparent to user. However, the examiner relied on Henckel to teach this limitation. Henckel et al. cite "A tuning page graphic 28 is displayed part way through this process of turning a page. In order to turn this page, the user touches the display device 10 somewhere on page 103" on page 2,

lines 50-65. Before the user swipes his hand from right to left across the surface of the display screen, the user could be able to see the page number of the immersive pages because it is transparent to the user.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner respectfully disagrees because both of the references disclose the same field of invention. These references disclose a method for editing and formatting data in a document including displaying a list of selectable features.

Henckel teaches the navigational functionality comprising displaying another immersive reading page of the electronic document, while Hutchinson teaches the step of "interactive region".

Moreover, in view of the guidance provided by the Supreme Court in *KSR* decision, a patent claim is prima facie obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person

having ordinary skill in the art. See the recent Board decision *EX parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007 (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>)).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

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Application/Control Number:  
09/465,879  
Art Unit: 2179

Page 13

Mylinh Tran

Art Unit 2179

A handwritten signature in black ink, appearing to read 'Weilun Lo', positioned above the printed name.

**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**